

REMARKS

Claims 1-36 and 58-106 are pending in the application, with claims 1, 58 and 71 being independent. Applicants propose to amend claims 1, 6, 58, 71 and 76 for clarification reasons by reciting “executable modules.” Support for the amendment may be found at least at page 23, lines 5-14; and page 12, line 22 to page 13, line 5. Pursuant to MPEP §714.13, Applicants contend that entry of the present amendments are appropriate because the proposed amended claims avoid the rejections set forth in the last Office Action, resulting in the application being placed in condition for allowance, or, alternatively, the revised claims place the application in better condition for purposes of appeal. Furthermore, the revised claims do not present any new issues that would require any further consideration and/or search by the Examiner, and the amendments do not present any additional claims without canceling a like number of pending claims. Accordingly, entry of the present amendment is respectfully requested. No new matter has been added. Reconsideration of the amendments and the application is respectfully requested in view of the amendments and following remarks.

Traversal of §102(b) Rejections

Claims 1-17, 25-36, 58-87 and 95-106 were rejected under 35 U.S.C. 102(b) as being anticipated by U.S. Patent No. 6,226,618 to Downs *et al* (“Downs”). This rejection is respectfully traversed.

For anticipation of a claim under 35 U.S.C. § 102, a single prior art reference must contain each and every limitation of the claim, either expressly or under the doctrine of inherency. Applicants submit that Downs does not disclose or suggest every limitation of claimed inventions.

Claim 1 (and similarly claims 58 and 71) as amended recite, in part:

selecting one or more executable modules for inclusion in the digital container. (Emphasis added)

As explained in the previous Amendment submitted October 24, 2005, the only type of secure container (SC) in Downs that might contain streaming content is the Content SC 630, which might be sent to an end user device, as described at col. 38 to col. 39, line 24, possibly with metadata. The other types of SCs in Downs (e.g., Transaction SC, License SC, Order SC, etc.) are therefore not germane to the inventions of independent claims 1, 58 and 71. As can be seen by the descriptions of the various types of SCs, there are significant differences between the system using SCs of Downs and the claimed invention. For example, nowhere does Downs disclose or suggest, in reference to the Content SC 630: “selecting one or more executable modules for inclusion in the digital container.” (Emphasis added)

In Downs, all executable modules always exist outside of Content SC 630, such as being already present on the client device (such as a PC) or are downloaded from a website, independent of the SC 630. For example, the player program 195 is downloaded from web sites to a user device (col. 80, lines 7-19). A careful inspection of Downs reveals that the player is never included the Content SC 630. Even when considering encryption in Downs, e.g., for encryption of the media content, Downs fails to disclose “selecting one or more executable modules” for inclusion as part of the Content SC 630, primarily because the client device is presumed to already have the decryption modules on the client device (see col. 79, lines 10-41). There is some encryption related information in Downs, which is a text file, but is placed in a metadata SC 620 as explained in the process table at col. 18, step 126, which states that the encryption key (text information) is packed in to metadata SC by packer tool 152. But, even this encryption key text information is not an executable module and is not included in the Content SC 630.

Therefore, Applicants submit that there is no disclosure, suggestion or motivation in Downs for including any type of executable modules in the Content SC 630. This is clearly different from independent claims 1, 58 and 71.

Furthermore, independent claim 58 recites in part:

accessing the secured streaming container (SSC) using the one or more executable modules to control playback of the streaming media content... (Emphasis added)

Applicants submit that neither Downs, nor any other prior art of record, contemplates these combinations of limitations. Downs does not disclose executable modules being included in the Content SC 630, therefore, there cannot be any accessing of executable modules to control playback of the streaming media content, as required by claim 58.

Therefore, since neither Downs, nor any other prior art of record, discloses all the limitations as recited by independent claims 1, 58 and 71, Applicants submit that independent claims 1, 58 and 71 are distinguished over the prior art of record and are allowable. Moreover, since claims 2-17, 25-36, 59-87 and 95-106 depend from an allowable independent claim, Applicants submit that these dependent claims are also allowable for at least their dependency, and also for distinguishable subject matter recited by the dependent claims.

For example, the Examiner incorrectly states on page 6 of the office action that the subject matter of claims 6, 63 and 76 is disclosed by Downs, and cites col. 7, lines 11-40 and col. 82, lines 51-60 for support. A close examination clearly shows that these two passages do not disclose the subject matter of claims 6, 63, and 76. Rather, at col. 7, lines 11-40, Downs is discussing Licensing and Clearinghouse operations in a broad manner. The passage at col. 82, lines 51-60 is broadly discussing encryption and decryption of content in the player application. Similarly, as discussed previously, there is no executable modules included in the Content SC 630 of Downs that controls streaming of one or more media files. Further, as demonstrated above, the player application is not included in the Content SC 630. In both of these cited passages, there is no indication whatsoever of the required limitations of claims 6, 63 and 76. Moreover, contrary to the Examiner's statement on page 6 of the Office Action, the encryption/decryption algorithms disclosed in this passage of Downs is not selected based on the type of media files. Further, these encryption/decryption algorithms are not included in the SC as a module; they simply perform a transformation of content outside of the SC environment and like most encryption functions are indifferent to the type of media file, as required by

claims 6, 63, and 76. Therefore, the cited passages do not provide the disclosure to support the Examiner's contention.

Also, as another example, in regards to dependent claims 7 and 77, the passage at col. 73, lines 17-28, as cited by the Examiner on page 6 of the office action, is in reference to a Metadata SC which is not equivalent to the claimed inventions, since Metadata SCs cannot provide the claimed limitations, as explained previously. Applicants respectfully submit that the Examiner is confusing at least two different types of digital containers in Downs. This passage does not disclose the subject matter recited by these claims. For example, claims 7 and 77 recite, in part:

wherein the digital container graphic is either a static image and an animated image and is at least one of informational and promotional graphics that appears on a viewable electronic digital container cover before and after the digital container is opened.

Applicants submit that the cited passage is referring to Metadata SCs selected on a website (see col. 73, line 15). As there are several types of SCs in Downs, this passage is again referring to the Metadata SC, which Applicants submit is not the same as the digital container as recited by claims 7 and 77, which must include streaming media, as explained above.

Also, as another example, the passages at col. 6, lines 45-48; col. 33, lines 63-67; and col. 82, lines 51-60, as cited by the Examiner on page 7 of the office action in regards to claims 13 and 83, clearly do not support the Examiner's assertion that Downs discloses the subject matter of claims 13 and 83. In fact, none of these passages provide any disclosure whatsoever about an html file or image file being viewable during playing of the one or more streaming files, as required by claims 13 and 83. The passage at col. 6, lines 45-48 simply defines digital content. The passage at col. 33, lines 63-67 simply states that HTML pages are displayed on receipt of the Transaction SC 640. This is much different than the SSC of the claimed invention since Transaction SCs of Downs do not contain streaming media content, as explained above. The passage at col. 82, lines 51-60 simply

discusses decryption by player 195, but says nothing about playing HTML or image file during playing of one or more streaming files, as required by claims 13 and 83.

In yet another example where the Examiner is clearly incorrect, in regards to claims 28 and 98 on page 8 of the office action, the cited passage at col. 33, lines 63-67 is referring to html displays when using a Transactional SC (see col. 33, line 20-24). Again the Examiner is relying on a type of SC (i.e., Transactional SC) in Downs that is not relevant to the claimed invention, as described above. Applicants submit that this is not the digital container as recited by claims 28 and 98, as there is no streaming digital content in a Transactional SC of Downs (rather a content URL), as explained previously.

Applicants submit that the §102(b) rejections should now be withdrawn.

Traversal of 103(a) Rejections

Claims 18-24 and 88-94 have been rejected under 35 U.S.C. 103(a) as being unpatentable over Downs. This rejection is respectfully traversed.

Referring the Examiner now to MPEP § 2143, titled "**Basic Requirements for a *Prima Facie* case of Obviousness**", the MPEP mandates that:

"To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine the reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all of the claimed limitations. (Emphasis added)

Applicants submit that the prior art does not disclose or suggest all the claimed limitations.

First, Applicants submit that the dependent claims 18-24 and 88-94 depend from an allowable independent claim and therefore are also allowable for at least this reason. Furthermore, Applicants vehemently disagree with the Examiner's conclusory statement on page 10 and 11 of the office action, in regards to claims 18, 20, 88 and 90, that "the use of XML is notoriously known for exchanging information across the Internet and can be created manually or through automation." Applicants submit that these statements in this portion of the rejection are not appropriate for the claimed subject matter, and are in error.

Applicants submit that claims 18, 20, 88 and 90 are directed to unencrypted XML tag sets included in the secured streaming container to be used by search engines to discover the secured streaming container or the streaming media content. Applicants submit that it is not at all obvious or well known to include unencrypted XML tag sets in the secured streaming container (i.e., having streaming content) and that this use of XML tags in a secured streaming container is certainly not obvious. Even Downs does not disclose or suggest this concept anywhere. In Downs, the use of HTML (which is not XML) is related to Offer SCs, and never when employing encrypted streaming media in an SSC. Therefore, this example in Downs is not relevant for supporting the Examiner's contention. Applicants submit that tagging an encrypted container with unencrypted XML is not obvious or well known to one of ordinary skill in the art. Simple awareness of XML does not provide a basis to motivate a skilled artisan to employ XML in the claimed invention.

Moreover, the concepts disclosed by Downs are much different than from the claimed inventions. For example, in Downs, as disclosed at step 132 at col. 18, Electronic Data Stores must pull metadata from Metadata SCs to acquire promotional data from the Metadata SC to promote the Content 113 on a Web site. This potentially burdensome step (pulling metadata from the Metadata SC) is not necessary in the invention, as the unencrypted XML tag sets provide, in part, search and discovery ability of secure streaming containers or media content that may include encrypted media to search engines. Applicants respectfully submit that using unencrypted XML tags for tagging encrypted streaming content is certainly not obvious or well known. Moreover, Downs does not disclose or suggest anywhere placing XML tags in a secured streaming container. Therefore, it would not have been obvious or well known to employ XML tags in Downs.

Because of these unique features, Applicants strongly disagree with the Examiner's official notice that the use of unencrypted XML tags to tag encrypted secure streaming containers is obvious. Applicants challenge and demand that the Examiner produce an authority for the Office Notice. Further, the Examiner's statement on page 9 of the office action that "Downs *et al* would have been able to accommodate the usage of XML documents since the main concern of Downs *et al* is for protecting secure

documents against unauthorized usage” is inappropriate reasoning for use of XML, since XML has little to do, if at all, with protecting unauthorized usage. This substantially inaccurate statement provides a basis demonstrating that the Official Notice is improper. Further, Applicants submit that “protecting secure documents against unauthorized usage” is not necessarily Downs’ main concern.

As to claims 21 and 91, the Examiner cites col. 61, bottom half, to support his contention that the subject matter of claims 21 and 91 are disclosed or suggested by Downs. However, this passage is again referring to a Metadata SC 620 which has no streaming media content, which is therefore not the same as the claimed invention. Therefore, this rejection is clearly improper.

As to claims 22 and 92, on review of the cited passage (col. 59, lines 31-36), Applicants submit that this passage does not disclose or suggest “XML tags provide access rights to the target device,” as recited by claims 22 and 92. Rather, this passage simply states that usage conditions define rights of the end user(s), but does not disclose anything about XML tags.

Applicants submit that the 103(a) rejections should now be withdrawn.

Serial No.: 10/798,371



RESPONSE UNDER 37 CFR 1.116
EXPEDITED PROCEDURE
GROUP ART UNIT 2131

Conclusion

Entry of the amendments is respectfully requested to place the claims in clear condition for allowance or better form for Appeal. Prompt and favorable reconsideration is requested of the application. The Examiner is invited to contact the undersigned at the telephone number listed below, if needed. Applicants hereby make a written petition for extension of time if needed. Please charge any deficiencies and credit any overpayment of fees to Attorney's Deposit Account No. 23-1951.

Respectfully submitted,

A handwritten signature in cursive script that reads "Charles J. Gross".

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